

## REMARKS

In the Office Action mailed on October 3, 2005, claims 1-2, 8, 12, 14-15, 23-26 and 30 have been rejected under 35 U.S.C. §103(a) as obvious over US Patent No. 5,758,465 to Logue (“the ‘465 patent”) in view of US Patent No. 4,543,763 (“the ‘763 patent”), and in further view of US Patent No. 6,205,730 to Hasan et al. (“the ‘730 patent”). Claims 23-25 and 30 have been cancelled. No other claims remain pending, except for new claims 31-35. The claims require elements not disclosed or suggested by the references, and the obviousness rejection is therefore traversed as discussed below.

It is noted that the Office Action indicates that claims 1-30 remain pending in the application and that no claims have been withdrawn. It is believed that this is error since multiple claims have been previously cancelled or withdrawn, and only the above referenced claims remain pending and have been rejected. Clarification is requested.

Claim 1 requires (among other elements) at least four anti-rotation elements spaced apart from the perimeter edge of the mounting portion generally planar top surface configured for counteracting a moment acting upon the rod hanger as the rod is threadably received by the rod receiving portion. Claim 1 has been amended to also require that the at least four anti-rotation elements be configured for penetratively engaging the substrate that the fastener is driven into and that frictionally holds the fastener.

These and other limitations are not disclosed by the cited references, alone or in combination. The Office Action admits that the ‘465 patent fails to disclose anti-rotation elements, and relies instead on the ‘730 and the ‘763 patents to disclose or

suggest the required anti-rotation elements. It is submitted that these references are not properly combined with the '465 patent, and further that even if combined they fail to teach or suggest all of the claimed requirements. As a result, claim 1 is allowable, as are claims depending therefrom.

**A. THE '730 PATENT'S TWO DIMPLES DO NOT MEET THE REQUIREMENTS OF CLAIM 1.**

Claim 1 requires four anti rotation elements. The '730 patent discloses only two dimples 42. Further, the two dimples 42 of the '730 patent do not meet the structural limitations required by claim 1. Claim 1 has been amended to require that the at least four anti-rotation elements be configured for penetratingly engaging the substrate that the fastener is driven into and that frictionally holds the fastener. The '730 patent fails to disclose or suggest this requirement.

Instead, the '730 patent teaches that its two dimples 42 engage a roofing membrane 18 that is *sandwiched between* the roofing plate 10 and a roof that holds the fastener in place. See the '730 patent, FIG. 3; column 4, lines 58-65. That is, the roofing membrane 18 engaged by the dimples 42 is different from the substrate that the fastener is driven into and that frictionally holds the fastener (i.e., the roof).

Claim 1 also has been amended to require penetrating engagement. The '730 patent expressly teaches away from this limitation: it is "...important that the dimples 42 ... lightly grip the roofing membrane without puncturing it..." Col. 4, lines 58-60. Because it is impermissible to combine a reference in an obviousness rejection

with a second reference that teaches away from it, the obviousness rejection of amended claim 1 over the '730 patent should be withdrawn. MPEP §2145(X)(D)(2).

**B. THE '763 PATENT FAILS TO DISCLOSE THE REQUIRED ANTI-ROTATION ELEMENTS.**

The '763 patent likewise fails to teach the anti-rotation elements required by claim 1. For example, the projections 22 of the '763 patent are not spaced apart from a mounting portion perimeter edge as is required by claim 1, but instead appear to be along the perimeter. See, the '763 patent, FIG. 1.

Also, the projections 22 of the '763 patent are not configured to counteract a moment acting upon the rod hanger as a rod is being threadably received by a rod receiving portion as is required by the claims, since the '763 patent only teaches a masonry anchor for threading a masonry structure. Abstract.

**C. THE '465 PATENT TEACHES AWAY FROM THE CLAIMED ANTI-ROTATION MEMBERS.**

Prior art references must be considered in their whole, including portions that would teach away from the claimed combination. MPEP §2141.02(I), (VI). It is improper to combine references for an obviousness rejection when they teach away from one another. MPEP §2145(X)(D)(2).

The '465 patent teaches that its engaging member 24 has a “generally flat ... top surface 42.” Col. 3, line 67 – col. 4, line 1, and therefore expressly teaches away

from the claimed anti-rotation members. One considering the '465 patent, therefore, would not be motivated to consider other references (such as the '730 or '763 patents) that arguably teach anti-rotation elements, and it is improper to combine the '465 patent with such references in an obviousness rejection. The '465 patent failed to recognize the problem of rotation of its engaging member as a threaded rod is rotatably received, which problem has been addressed by the presently claimed invention.

**D. THE '465, '763 AND '730 PATENTS ARE FROM UNRELATED ARTS AND THERE IS NO MOTIVATION TO COMBINE TEACHINGS.**

There must be some suggestion or motivation disclosed in the references or in the commonly known art to combine the cited references to support an obviousness rejection. MPEP §2143.01. Assuming for sake of argument only that the required anti-rotation elements are disclosed or suggested by one or more of the cited references, it is submitted that the obviousness rejection remains improper because there is no motivation to combine them with both of the others. Citing these references in an obviousness rejection improperly views the prior art with the benefit of hindsight gained only after considering the claims.

The '465 patent teaches a clip and method for securing a rod to a ceiling. As best understood, the disclosed device is for interior use on interior ceilings. The '730 patent, on the other hand, discloses a roofing plate for holding exterior roofing membrane on an exterior roof. The '763 patent teaches a masonry anchor useful to thread a hole in masonry: "...the purpose of the plate 20 is to control the rate of penetration of the anchor

10 to assure proper formation of threads 2.” Col. 3, lines 61-63. As best understood, this is not a device for securing anything, much less a rod, to a substrate.

These teachings are unrelated and one considering any of the references would not be motivated to consider either of the others. It is further noted that all three of these references have been cited in combination. Assuming only for the sake of argument that consideration of one of the references might possibly be led to one of the other two, it is submitted that the chances the third unrelated reference then being combined with the other two are nil.

It is also noteworthy that the ‘763 patent issued more than 20 years ago. The fact that no reference has been found that combines features of the ‘763 patent with those of references such as the ‘465 patent (issued more than 7 years ago) or the ‘730 patent (issued more than 4 years ago) despite over 20 years since publication is further evidence that no motivation exists to combine the teachings.

#### **E. DEPENDANT CLAIMS ARE ALLOWABLE FOR ADDITIONAL REASONS.**

Several of the dependent claims include additional requirements that provide independent basis for allowability of the claims over the cited references. For example, claim 15 requires a generally truncated cone shaped anti-rotation element. The Office Action admits that the cited references fail to disclose this required element, but suggests it would be obvious to modify the teachings of the ‘730 patent to achieve this. It is submitted that this is improper, however, since the ‘730 patent expressly teaches away

from this limitation: “It is important to note that the dimples 42 have rounded tips so that they may lightly grip the roofing membrane 18 without puncturing it...” Col. 4, lines 58-60. It is therefore improper to cite the ‘730 patent in an obviousness rejection of claim 15, and the claim is allowable.

#### F. NEW CLAIMS 31-35 ARE ALLOWABLE.

New claims 31-35 have been presented for consideration and are believed to be allowable. Claim 31 depends from claim 1 and requires that the anti-rotation members further include a resilient cover for enhancing the adhesion of the mounting portion with the substrate. Claim 32 depends from claim 31 and further requires that the resilient cover is formed of a polymer, extends fully over the anti-rotation member, and that the resilient cover is secured to the anti-rotation members by one of chemical adhesive or thermoforming. Support for claims 31-32 is found, for example, on page 7, lines 3-8 of the specification.

New claim 33 depends from claim 1 and requires that the hole through the mounting portion be defined by a substantially smooth sidewall. New claim 34 depends from claim 1 and requires that the hole through the mounting portion have a diameter substantially larger than the fastener shank portion whereby the shank passes freely therethrough. Support for claims 33-34 can be found, for example, in FIGS. 2-15. This requirement further clarifies differences between the claimed invention and the disclosure of the ‘763 patent, which requires its opening 21 in the plate 20 to have threads tapped to match the threads of the anchor to allow engagement between the anchor and the plate.

Col. 2, lines 10-14. This is required by the '763 patent, since it teaches an anchor for threading a hole in masonry, not a rod hanger. It is submitted that these limitations provide further evidence that the disclosure of the '763 patent is from an unrelated art that would not be considered by one knowledgeable in the art of rod hangers.

New independent claim 35 requires, among other elements, a mounting portion defined by a smooth sidewall and having a diameter larger than the fastener shank to thereby allow the fastener to pass freely therethrough. Claim 35 also requires that the anti-rotation members penetrate the substrate, and that the anti-rotation members be covered with a resilient cover formed of a polymer. As discussed hereinabove, the cited references fail to disclose these elements. For these and other reasons, claim 35 is allowable.

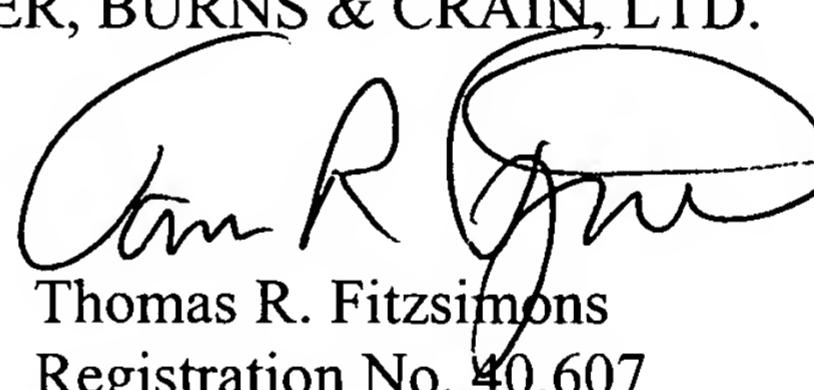
G. CONCLUSION.

It is submitted that all of the claims in their current form are allowable over the cited prior art. Timely examination and allowance is respectfully requested. Should the Examiner discover there are remaining issues which may be resolved by a telephone interview, he is invited to contact Applicant's undersigned attorney at the telephone number listed below, or Lisa Soltis, Applicant's primary attorney, at (847) 657-7980. All correspondence should continue to be directed to Ms. Soltis at the correspondence address of record.

Respectfully submitted,

GREER, BURNS & CRAIN, LTD.

By

A handwritten signature in black ink, appearing to read "Tom R. Fitzsimons".

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